

**REMARKS**

Favorable reconsideration and allowance are respectfully requested for Claims 2-11 and 27-36 in view of the foregoing amendments and the following remarks.

At the outset, we would like to express our appreciation to Examiner Lee for the courtesies extended during the telephone interviews conducted in May 2002.

During the interviews, the JP' 747 reference was discussed in relation to wood veneers and metal parts being molded. No agreement was reached.

The foregoing amendments and the following remarks are directed towards the Patent Business Goals to continue prosecution. Claim 1 has been cancelled, and Claims 4, 8 and 11 have been amended to independent form.

Claims 1 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by JP 56-005747 (JP '747). These rejections are respectfully traversed. Regarding Claim 1, in view of the cancellation of Claim 1, this rejection is deemed moot. Regarding Claim 11, the rejection is respectfully traversed.

JP '747 does not disclose or suggest, among other features, the closing of the mold comprising simultaneously cutting and stamping of the décor part. JP '747 relates to a decorative film which is cut when the molds are closed and, at the same time, molten resin is injected on the side of a core. This is done due to the film plate being a floating article in the mold after cutting. As seen in Figures 1-9, the film plate is never stamped between two portions of the mold. The injection of the resin appears to suggest that the film plate is deep-drawn by the injection process. Thus, JP '747 does not show a stamping. Therefore, it is

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respectfully submitted that the claimed invention is not anticipated by JP '747, as set forth above. Accordingly, withdrawal of the rejections is respectfully requested

Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over JP '747. In view of the new dependency of Claims 2 and 3, this rejection is deemed moot.

Claims 4-7, 27-32 and 36 were rejected under 35 U.S.C. §103(a) as being upatentable over JP '747 in view of Kato et al. These rejections are respectfully traversed. JP '747 does not disclose or suggest, among other features, the décor part is a veneer wood layer. As noted in the Office Action, JP '747 indeed does not disclose such a décor part.

The deficiencies of JP '747 are not rectified by Kato et al. A *prima facie* case of obviousness is not supported with the combination of JP '747 and Kato et al. The motivation to combine JP '747 and Kato et al. is recited in the Office Action as the references are analogous with respect to molding a decorative part, and that to substitute a sheet of the décor part of Kato et al. for the décor part of JP '747 is in order to form a more diverse product, such as an automobile covering or trim part having a wood veneer appearance. Applicant respectfully disagrees. Kato et al. teaches that the composite, generally indicated as 1, is for reinforcement purposes (see column 2, line 13). Kato et al. further discloses that the composite article 1 must be pre-shaped, and a second mold 7 is used to form the actual article (see column 4, lines 30-31). Kato et al. also suggests that the composite laminate 1 must be cut to a predetermined shaped before setting in a metal mold for prefabrication (see column 5, lines 23-24). As the laminate in Kato et al. deals with wood veneer and metal reinforcement, no suggestion is made in JP '747 that the mold may cut such a material. Likewise, as JP '747 deals with a floating article after cutting, and Kato et al. deals with a pre-set

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article in the mold, neither reference suggests that the processes may be combined. In view of the properties of the laminate in Kato et al. and the teachings that a pre-molding, pre- deep-drawing or pre-cutting of the laminate is required, the material of Kato et al. is unsuitable for the process of JP '747. Thus, at the time the invention was made, one of ordinary skill in the art would not substitute the sheet of the laminate of Kato et al. for the film part of JP '747.

Neither reference suggests the mold cutting a wood veneer. A *prima facie* case of obviousness has not been established for the combination of JP '747 and Kato et al. in that the substitution of materials is unsuitable based upon the teachings of Kato et al., and the motivation to combine the references is unsupported. Thus, it is respectfully submitted that the claimed invention is patentably distinguishable over the combination of Kato et al. and JP '747, as noted above. Accordingly, withdrawal of the rejections is respectfully requested.

Claims 8 and 9 were rejected under 35 U.S.C. §103(a) as unpatentable over JP '747 in view of Conner. These rejections are respectfully traversed. JP '747 does not disclose or suggest, among other features, the décor part comprises a sheet metal part. JP '747 discloses only a film plate.

The deficiencies of JP '747 are not rectified by Conner. Conner does not disclose or suggest, among other features, the décor part comprises a sheet metal part. Conner relates to simulated decorative surfaces (see column 2, lines 7-8). As disclosed at column 5, lines 9-18, the layer or coating 45 is vacuum metalized or deposited and is not a sheet metal part. This coating is used to achieve desired metalized hue or coloring effects. Conner does not suggest that a sheet metal part is used. Thus, it is respectfully submitted that the claimed invention is patentably distinguishable over JP '747 in view of Conner, as noted above. Accordingly, withdrawal of the rejections is respectfully requested.

Regarding the combination of JP '747 and Conner, a *prima facie* case of obviousness has not been established. The motivation to combine the décor part of Conner with the film plate of JP '747 is given in the Office Action as substitution in order to further diversify the decorative molding of JP '747. As Conner deals with a throughput automation of decorative molded articles, the motivation to combine the references is unsupported. Conner specifically deals with a decorative tape wound onto wheels 28 and 30. Conner deals with high throughput manufacture where the decorative tape is unreeled and passed through the mold and, in turn, wound around wheel 30, as seen in Figure 1. This tape, when molded, adheres the decorative surface to the article and releases the carrier portion 31. This carrier portion is then, in turn, advanced out of the mold and serves as a leader for drawing an extra adjacent predetermined desired length of decorative tape into the mold for repetition of article forming (see column 4, lines 47-54). The use of this tape in JP '747 is unsuitable in that JP '747 would cut the tape and not allow the high throughput and repetition as shown in Conner. Thus, one of ordinary skill in the art would not look to Conner to substitute the material in JP '747. Conner teaches away from the process envisioned in JP '747 in that cutting the tape does not allow the high throughput. Therefore, a *prima facie* case of obviousness has not been established in that the teachings and material of Conner are unsuitable for the process of JP '747.

Claims 10 and 35 were rejected under 35 U.S.C. §103(a) as unpatentable over JP '747 in view of Stickling. In view of the new dependency of Claim 10, this rejection is respectfully deemed moot. Moreover, as Stickling teaches that the blank is pre-cut and pre-placed into the mold, one of ordinary skill in the art would not look to the teachings of Stickling in order to modify the process of JP '747. The process of JP '747 deals with a floating article in a mold, and the

process of Stickling, dealing with the embedding of the fasteners, is unsuitable for the process in JP "747.

Since Claims 33 and 34 depend from Claim 27, Claims 33 and 34 are also patentably distinguishable over the cited references. Accordingly, withdrawal of the rejections is respectfully requested.

In view of the foregoing amendments and remarks, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #225/47721).

Respectfully submitted,



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**MARKED-UP VERSION OF AMENDMENTS**

2. (Amended) A process according to Claim [1,] 4  
wherein the injection molding takes place at a temperature of  
approximately 150°C.

3. A process according to Claim [1] 4, wherein the mold has a  
temperature of 150°C.

4. (Amended) A process [according to Claim 1,] for manufacturing a  
covering or trim part with a directly molded-on carrier, comprising:

placing a decor part into an at least two-part injection mold;

closing the mold, thereby cutting the decor part to precise contours  
in the injection mold by shearing off an outer portion of the decor part;

pressing the cut decor part by injecting a molding compound against  
a surface of the decor part opposite at least one injection opening;

connecting the injection molding compound with the decor part  
during hardening of the molding compound, wherein the molding compound  
forms the carrier; and

opening the injection mold and removing the covering or trim part  
and molded-on carrier,

wherein the decor part is a veneer wood layer.

8. (Amended) A process [according to Claim 1,] for manufacturing a  
covering or trim part with a directly molded-on carrier, comprising:

placing a decor part into an at least two-part injection mold;

closing the mold, thereby cutting the decor part to precise contours  
in the injection mold by shearing off an outer portion of the decor part;

pressing the cut decor part by injecting a molding compound against a surface of the decor part opposite at least one injection opening;

connecting the injection molding compound with the decor part during hardening of the molding compound, wherein the molding compound forms the carrier; and

opening the injection mold and removing the covering or trim part and molded-on carrier,

wherein the décor part comprises a sheet metal part and the process further comprises:

applying a coupling layer to the backside of the sheet metal part;  
and

heating or activating the coupling layer with the injection molding compound.

10. (Amended) A process according to Claim [1] 4, further comprising embedding fastening elements for the covering or trim part in the injection molding compound.

11. (Amended) A process [according to Claim 1,] for manufacturing a covering or trim part with a directly molded-on carrier, comprising:

placing a decor part into an at least two-part injection mold;

closing the mold, thereby cutting the decor part to precise contours in the injection mold by shearing off an outer portion of the decor part;

pressing the cut decor part by injecting a molding compound against a surface of the decor part opposite at least one injection opening;

connecting the injection molding compound with the decor part during hardening of the molding compound, wherein the molding compound forms the carrier; and

opening the injection mold and removing the covering or trim part  
and molded-on carrier,

wherein the closing of the mold comprises simultaneously cutting  
and stamping the decor part.